

**REMARKS**

**Status of Claims**

Claims 1-38 stand rejected. Claims 1-38 are pending in this Application.

**Telephonic Interview**

The Applicants thank Primary Examiner Hirsch for conducting a telephonic interview on October 17, 2000 with the Applicants' representative Christopher M. Turoske (Reg. No. 44,456). During the interview, the general status of the case was discussed, and U.S. Patent No. 5,875,918 ("Sheffler et al.") was generally discussed.

**Offer To Surrender The Original Patent**

In Section 1 of the Office Action, the Primary Examiner stated that the "reissue application was filed without the required offer to surrender the original patent." The offer to surrender the original patent was filed with the present reissue application on December 21, 1999, a copy of which is provided herewith for the Primary Examiner's convenience. The Applicants intend to provide the original patent (or if the original is lost or inaccessible an affidavit or declaration to that effect) before this reissue application is formally allowed as required by 37 C.F.R. § 1.178.

**Declaration Under 37 C.F.R. § 1.63**

In Section 4 of the Office Action, the Primary Examiner rejected Claims 1-38 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. The Examiner stated:

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 C.F.R. 1.175(a)(1) and MPEP § 1414. . . . The Declaration states that the error being relied on is that while a living hinge is support, "Claims 1-20 of the '486 patent do not appear to explicitly recite 'a hinge'". However, Claim 7 explicitly claims a living hinge between the first piece and second piece as referencing the cover piece having a first interface, and the base piece having a second interface. . . . Accordingly, the error

referred to is clearly not an error since it is recited in the claims of the patent and does not constitute proper grounds for a reissue.

The Applicants have provided a Supplemental Declaration that identifies an error upon which the reissue application is based as required by the Examiner.

**Support for Claim Amendments**

Claims 1, 6, 8, 11-12, 14-15, 19, 23, 25 and 27 have been amended to more particularly point out and distinctly claim the subject matter recited in those claims. Support for the amendments to Claims 1, 6, 8, 11-12, 14-15, 19, 23, 25 and 27 may be found at col. 5, lines 47-57 of the Specification, stating:

In the process of closing insert 22, groove 48 receives peripheral rim 36 between first peripheral wall 44 and peripheral edge 33 (FIGS. 4, 6, and 8), thereby effecting a hermetic, i.e., air-tight, seal at the interface. The seal can be formed between peripheral wall 34 and peripheral wall 44 or rim 36 and edge 33. Moreover, bulge 54 of peripheral edge 33 pushes peripheral rim 36 to bias peripheral wall 34 towards peripheral wall 44. Even further, lip 38 of peripheral rim 36 fits into indentation 56 of peripheral edge 33, thus securing the hermetic seal and maintaining insert 22 in the closed configuration.

Additional support for the amendments to Claims 1, 6, 8, 11-12, 14-15, 19, 23, 25 and 27 may be found at col. 5, lines 8-12 of the Specification ("[P]eripheral edge 33 includes a chamfer edge 52, a bulge 54 protruding in a direction toward groove 48, and an indentation 56 pointed in a direction away from wall 44. A groove 58 is disposed between shorter peripheral wall") and FIGURES 7-8.

No new matter has been added.

**Claim Rejections - 35 U.S.C. § 112 ¶ 2**

In Section 5 of the Office Action, the Primary Examiner rejected dependent Claims 11 and 27 under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Dependent Claims 11 and 27 have been amended as prescribed by the Primary Examiner. Claims 11-12 and 27-34, as amended and/or as originally presented, now particularly point out and distinctly claim the subject matter recited in

Claims 11-12 and 27-34 in compliance with 35 U.S.C. § 112 ¶ 2. Accordingly, the rejection has been overcome.

**Claim Rejections - 35 U.S.C. § 102(b)**

In Section 7 of the Office Action, the Primary Examiner rejected Claims 1-3, 8, 14-15, 18-20, 22-23, 35 and 37-38 under 35 U.S.C. §§ 102(b) and 102(e) as being anticipated by U.S. Patent No. 5,875,918 ("Sheffler et al.").

Sheffler et al. shows a "container" having a "sealing mechanism which relies essentially on a relatively high, linear or in-like pressure track or area that is established by a sharp, substantially 90 degree apex or corner configuration" (see Sheffler et al. at col. 5, lines 26-29 emphasis added, and Figures 1-2).

Sheffler et al. does not identically disclose the combination of elements recited in independent Claims 1, 8, 14 and 23 (as amended). For example, independent Claims 1 and 14 (as amended), recite a "makeup container" (Claim 1) or "makeup case" (Claim 14) including, among other elements, a "rim" configured to engage a "groove" having a "bulge" (Claim 14) wherein "the hermetic seal is formed between the rim and the groove at a plurality of sealing locations" (Claim 1) or "the rim being received in the groove in at least partial planar engagement with the bulge when the cover is in the closed position" (Claim 14); and Claims 8 and 23 recite a "compact" including, among other elements, a "first section" (Claim 8) or a "first platform [with] a channel [having] at least one generally planar sealing surface" (Claim 23) and a "second section" (Claim 8) or "second platform [having] a rim" (Claim 23) wherein "the first section engaging the second section in generally planar contact to form the air-tight seal, the air-tight seal maintaining the first section in a closed position with respect to the second section" (Claim 8) or "wherein when the second platform is in the first position the rim is received by the channel to provide a generally hermetic seal between the first platform and the second platform at the at least one generally planar sealing surface" (Claim 23), which is not identically disclosed in Sheffler et al. Accordingly, independent Claims 1 (and corresponding dependent Claims 2-3), independent Claim 8, independent Claim 14 (and corresponding dependent Claims 15, 18-20 and 22), and independent Claim 23 (and corresponding dependent Claim 35) are

not anticipated by Sheffler et al. under 35 U.S.C. §§ 102(b) and 102(e) and are patentable.

The subject matter recited in independent Claim 37 is not identically disclosed by Sheffler et al. Claim 37 (as originally presented) recites an element that invokes 35 U.S.C. § 112 ¶ 6 (i.e., "means for forming a generally hermetic seal"). The Applicants respectfully request a clarification of the rejection to Claim 37, and that the Primary Examiner "provide an explanation and rationale in the Office Action as to why the [Sheffler et al.] element is an equivalent" (see Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, ¶6, Fed. Reg. Vol. 65, No 120 June 21, 2000<sup>1</sup>). Sheffler et al. states that an "air-tight seal" may be obtained (see col. 6, lines 29-33). However, the "means for forming a generally hermetic seal" recited in Claim 37 is not accomplished in substantially the same way as shown in Sheffler et al. Accordingly, independent Claim 37 (and corresponding dependent Claim 38) is not anticipated by Sheffler et al. under 35 U.S.C. §§ 102(b) and 102(e) and is patentable.

#### Claim Rejections – 35 U.S.C. § 103(a)

In Section 9 of the Office Action, the Primary Examiner rejected dependent Claims 4-7, 21, 24-32 and 36 under 35 U.S.C. § 103(a) as being obvious over Sheffler et al., a single reference. In Section 10 of the Office Action, the Primary Examiner rejected dependent Claims 9-13 and 16-17 under 35 U.S.C. § 103(a) as being obvious over Sheffler et al. in view of U.S. Patent No. 4,454,889 ("Contreras, Sr."). In Section 11 of the Office Action, the Primary Examiner rejected dependent Claims 33-34 under 35 U.S.C. § 103(a) as being obvious over Sheffler et al. in view of U.S. Patent No. 4,568,519 ("Seidler et al.").

Claims 1, 8, 14 and 23 are in independent form. Claims 4-7 depend from independent Claim 1, Claims 9-13 depend from independent Claim 8, Claims 16-17 and 21 depend from independent Claim 14, and Claims 24-34 and 36 depend from independent Claim 23.

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<sup>1</sup> Available at <http://www.uspto.gov/web/offices/com/sol/notices/fr112p6.html>.

Sheffler et al. relates to a "hermetically-sealed container and closure construction." Contreras, Sr. relates to a "compact with air tight closure." Seidler et al. relates to a "compact case."

Sheffler et al., as modified or in combination with Contreras, Sr. and/or Seidler et al., would not result in the subject matter recited in independent Claims 1, 8, 14 and 23, as amended (or Claims 4-7 that depend from independent Claim 1, Claims 9-13 that depend from independent Claim 8, Claims 16-17 and 21 that depend from independent Claim 14, and Claims 24-34 and 36 that depend from independent Claim 23) because the proposed modification of Sheffler et al. or combination with Contreras, Sr. and/or Seidler et al. does not disclose, teach or suggest the "compact", "container" or "case" recited in independent Claims 1, 8, 14 and 23 (as amended). Furthermore, to transform Sheffler et al. (alone or in combination with Contreras, Sr. and/or Seidler et al.) into the "compact", "container" or "case" recited in independent Claims 1, 8, 14 and 23 (as amended) would require still further modification, and such modification is taught only by the Applicants' own disclosure. The subject matter recited in independent Claim 1 (and corresponding dependent Claims 4-7), independent Claim 8 (and corresponding dependent Claims 9-13), independent Claim 14 (and corresponding dependent Claims 16-17 and 21) and independent Claim 23 (and corresponding dependent Claims 24-34 and 36), considered as a whole, would not have been obvious to a person having ordinary skill in the art and are patentable. Accordingly, the Applicants request withdrawal of the rejection of dependent Claims 4-7, 9-13, 16-17, 21, 24-34 and 36 under 35 U.S.C. § 103(a).

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The Applicants respectfully submit that each and every outstanding objection and rejection has been overcome, and the present Application is in a condition for allowance. The Applicants request reconsideration and allowance of pending Claims 1-38.

The Primary Examiner is invited to telephone the undersigned if such would advance the prosecution of the Application.

Respectfully submitted,

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By



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